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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/342,453	06/29/1999	EDGAR J. ST. PIERRE	E0295/7100/R	6555

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EXAMINER

THAI, TUAN V

ART UNIT PAPER NUMBER

2186

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

453  
09/342,435

Applicant(s)

BROWN ET AL.

Examiner

Tuan V. Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 40-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**Part III DETAILED ACTION**

***Specification***

1. Claims 1-39 are presented for examination. Claims 40-54 are subjected to the restriction requirement, and being withdrawn from further consideration.
2. Applicant is reminded of the duty to fully disclose information under 37 CFR 1.56.

**NOTIFICATION OF OBJECTION AND/OR REJECTIONS**

***Election of Species/Restriction***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-39 drawn to a method of partially duplicate backup data stored in the backup storage medium.

Group II. Claims 40-45, drawn to a method of merging data from plurality of backup storage media onto a single duplicate backup storage.

Group III. Claims 46-52, drawn to a method of restoring data from the duplicate backup storage medium.

Group IVV. Claims 53-56, drawn to a method of sequentially backing up of data from one computer-readable backup storage medium to a second computer-readable backup storage medium.

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The inventions are distinct, each from the other for the following reasons:

The invention of groups I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group I has separate utility such as backing-up of only changing data from one storage medium to the others, and is not limited for use with the merging of data of group II, restoring data of group III, and sequentially backing of data from one computer readable storage medium to other computer readable storage medium of group IV. See M.P.E.P. § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and recognized divergent subject matter, and because the search required for one group is not coextensive with the search required for the other groups, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Richard F. Giunta, (Reg. No. 36,145) on October 31, 2002; a provisional election was made without traverse to prosecute the invention of group I, claims 1-39. Claims 40-54 are therefore withdrawn from further consideration by the Examiner.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-24 and 30-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Whiting et al. (USPN: 5,778,395); hereinafter Whiting;

After close analysis, the current invention is directed toward apparatus and method for partially duplicating backup-data stored in the one backup storage medium to another storage medium wherein numerous references can be used as prior arts; as per claims 1, 7, 13, 20, 30-31, 36, 37 and 38; Whiting discloses the invention as claimed including copying only a subset of the backup data onto at least one computer-readable duplicate backup storage medium as duplicate backup data so that the duplicate backup storage medium is not an exact duplicate of the at least one backup storage medium is being equivalently taught by Whiting as *after the initial backup on a particular volume (disk space),*

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*ONLY those files which have changed since the previous backup are actually read from the volume and stored on the backup storage* (emphasis added, e.g. see abstract, column 5, lines 7 et seq.);

As per claims 2-3, 8-9; 14-16; Whiting discloses copying a subset of the plurality of work items onto the duplicate backup storage medium having different properties as only those files/data which have changed since the previous backup are actually read from the volume and stored on the backup storage means of disk spaces of different network file server which is known to have different properties (e.g. see abstract, column 5, lines 20 et seq.; column 6, lines 20 et seq.);

As per claims 4, 10, 17; copying the subset of the backup data onto at least one duplicate backup storage medium of a different type than the at least one backup storage medium (e.g. see column 6, lines 20 et seq.);

As per claims 5, 11, 18; storing in a logical duplication database a record indicating that the subset of the backup data copied which has been copied to the at least one duplicate backup storage medium (e.g. see column 8, lines 8 et seq.);

As per claims 6, 12, 19; Whiting discloses wherein the at least one backup storage medium comprises a first backup storage medium including incremental backup data for at least one data item ... as being equivalent to the concept of delta computation wherein differences between file versions are computed so that

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only the changes to the file need to be written on the backup storage means; noting that Whiting discloses the backup process creates two files containing information about each backup set wherein these files could be combined into a single file (e.g. see column 5, lines 20 et seq.; column 6, lines 25 et seq.; column 8, lines 42 et seq.);

As per claims 21, 32; Whiting discloses wherein the first work item is stored on a single backup storage medium, wherein the backup data further includes a second work item stored in the single backup storage medium, and wherein the method includes a step of not duplicating the second work item onto the duplicate backup medium is equivalently taught as ONLY those files which have changed since the previous backup are actually read from the volume and stored on the backup storage (e.g. see abstract, column 5, lines 7 et seq.);

As per claims 22, 33; Whiting discloses that backup data being stored on the backup storage means of disk spaces of different network file server which is known to have different properties (e.g. see abstract, column 5, lines 20 et seq.; column 6, lines 20 et seq.);

As per claims 23, 34; Whiting discloses storing in a logical duplication database a record indicating that the first work item has been copied to the at least one duplicate backup storage means (e.g. see column 8, lines 8 et seq.);

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As per claims 24, 35; Whiting disclose that 32 bit modification time is written and including both the time and date when the file was last modified, Whiting further discloses that in more advance system, several other time values could be added such as last access time, creation time, or expiration time being claimed in the current invention (e.g. see column 10, lines 38 et seq.);

***Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiting et al. (USPN: 5,778,395); hereinafter Whiting;

As per claims 25-29; Whiting discloses the invention as claimed, detailed above with respect to claims 20-24; Whiting however does not particularly disclose a computer-readable medium having of instructions to carry out the steps of claims 20-24 to be implemented on a computer as being claimed in claims 25-29.



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However, one of ordinary skill in the art would have recognized that computer readable medium (i.e., floppy, cd-rom, etc.) carrying computer-executable instructions for implementing a method, because it would facilitate the transporting and installing of the method on other systems, is generally well-known in the art. For example, a copy of the Microsoft Windows operating system can be found on a cd-rom from which Windows can be installed onto other systems, which is a lot easier than running a long cable or hand typing the software onto another system. The examiner takes Official Notice of this teaching. Therefore, it would have been obvious to put Whiting's program on a computer readable medium, because it would facilitate the transporting, installing and implementing of Whiting's program on other systems.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

***After-final***

***(703) 746-7238***

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**Official** (703) 746-7239

**Non-Official/Draft** (703) 746-7240

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

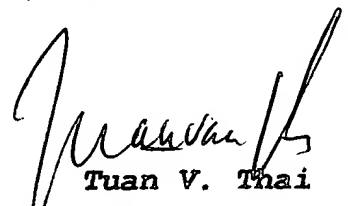
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Thai whose telephone number is 703-305-3842.

The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays or e-mailed at ***tuan.thai@uspto.gov***;

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Matthew M. Kim can be reached on (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**TVT**/October 31, 2002

  
**Tuan V. Thai**  
**PRIMARY EXAMINER**  
**Group 2100**

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes **incorporated** therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.